REMARKS/ARGUMENTS

Drawing Objection

The drawing was objected to for various reasons.

(1) With respect to the office's concern regarding missing drawing element numbers in Figure 1D, applicant makes reference to the previously submitted replacement drawing of 4/7/11. Applicant notes that 37 CFR 1.84(p)(5) requires that reference characters not mentioned in the description shall not appear in the drawings. As there are no reference characters noted in the description, no reference characters are provided in Figure 1D.

(2) With respect to the examiner's concern regarding the lack of reference character 100A, applicant amended the specification to correct numeral "100A" to read --100--.

(3) With respect to the examiner's concern regarding the presence of the reference character 100 in Figure 1, applicant amended the specification to correct numeral "100A" to read --100--.

Specification Objection

The specification was objected to for various reasons.

(a) Applicant amended the specification to remove bolding and underline as noted in MPEP 608.01(a)(c). The objection should be overcome.

(b) Reference character "100A" was amended to read --110--. The objection should be overcome.

(c) The brief description of Figure 3 was corrected to refer to Figure 3 as a perspective view. The objection should be overcome.

(d) Reference character "100A" was amended to read --110--. The objection should be overcome.

(e) Reference characters "120A and 120A'" were replaced with --120A' and 120A"-- The objection should be overcome.

Claim Objection

The examiner objected to claim 9 for containing the word "fluidly". Claim 9 was amended to express that the coupling is such that a fluid can flow from the first section to the second section via the inner portion of the field joint. The objection should be overcome.

35 USC § 112(2nd paragraph)

Claim 9 was rejected under 35 USC § 112(2nd paragraph) for lack of clarity. Applicant amended claim 9 to even more clearly point out that the field joint has an inner portion and an outer portion, that the product conduit has a first and a second section, and that the jacket of the pipeline has a first and a second section. The rejection should thus be overcome.

Reply to Response to Arguments

(a) Applicant agrees with the examiner that claims directed to a device must be distinguished from the prior art in terms of structure rather than function, and that the absence of disclosure in a prior art reference relating to a function of the device does not overcome anticipation by the device where the function is inherent in the prior art reference. However, applicant does not claim a new function for the known device of McKay, but characterizes certain elements by their specific capabilities using functional limitations.

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. MPEP 2173.05(g). In the instant case, applicant defined the manner of coupling the inner transition element to the first and second cryogenic pipelines using

functional language reciting the particular capability or purpose that is served by the coupling and inner transition element. Likewise, applicant defined the manner of coupling the first and second outer transition elements to the first and second cryogenic pipelines using functional language reciting the particular capability or purpose that is served by the coupling and the elements/pipelines. Clearly, such language is permissible under current rules and practice.

(b) Applicant respectfully disagrees with the examiner's apparent argument that inner transition element would form a conduit that is configured to allow transfer of a cryogenic fluid from first to second pipelines. McKay describes element 58 as a sleeve and it is abundantly clear from the Figures (esp. 4 and 7) that the sleeve surrounds the pipeline and not transfers cryogenic liquid.

35 USC § 102(b)

The office maintained the rejection of **claims 1-7 and 9-14** under 35 USC § 102(b) as being anticipated by McKay et al. (U.S. Pat. No. 3,865,145). The Applicant again respectfully disagrees.

With respect to the examiner's response to arguments, please see applicant's comments above. Notwithstanding the above arguments, applicant has further amended the claims to help advance the present matter. More specifically:

Claim 1 was amended to expressly require that (1) the inner transition element is coupled to and between a first cryogenic pipeline and a second cryogenic pipeline to thereby form a continuous conduit that allows transfer of a cryogenic product from the first cryogenic pipeline through the inner transition element to the second cryogenic pipeline, and (2) the first and second outer transition elements are coupled to a first and a second jacket pipeline respectively, and that the first and second outer transition elements are coupled to the first and second cryogenic pipelines via the inner transition element, respectively, to thereby allow transfer of thermal stress load in the first and second cryogenic pipelines to the first and second jacket pipelines, respectively. These elements are neither taught nor suggested by McKay. With respect to the examiner's analysis of the dependent claims, the same defects apply and are not reiterated here.

Claim 9 was amended to expressly require that (1) the inner portion of the field joint is configured to allow coupling of a first and a second section of a product conduit of the pipeline to opposite ends of the inner portion, respectively, such that a fluid can flow from the first section of the product conduit through the inner portion to the second section of the product conduit, (2) the outer portion of the field joint is configured to allow coupling together of a first and a second section of a jacket of the pipeline to opposite ends of the outer portion, respectively, and (3) the inner and outer portions of the field joint are coupled together such that a contraction force from the first and second sections of the product conduit is converted into a compression force to the first and second sections of the jacket in the pipeline, respectively. These elements are neither taught nor suggested by McKay. With respect to the examiner's analysis of the dependent claims, the same defects apply and are not reiterated here.

For at least these reasons, the rejections should be withdrawn.

35 USC § 103(a)

The office maintained the rejection of **claim 8** under 35 USC § 103(b) as being obvious over McKay et al. (U.S. Pat. No. 3,865,145). The Applicant once more respectfully disagrees.

Since McKay fails to teach each and every element as pointed out above, combination of McKay with the knowledge of the PHOSITA fails to properly render claim 8 obvious over McKay. For at least these reasons, the rejections should be withdrawn.

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Request For Allowance

Claims 1-20 are pending in this application, with claims 15-20 being withdrawn. The applicant requests allowance of all pending claims.

Respectfully submitted,
Fish & Associates, PC

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